



176

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Steven J. Geissler
Serial No. : 10/826534
Filing Date : April 16, 2004
Title : Method And Apparatus For Receiving A
Universal Input Voltage In A Welding,
Plasma Or Heating Power Source
Attorney Docket No. : ITW 8637.62

Disclosure of Prior Art, Litigation, and Litigation Documents

Honorable Commissioner of
Patents and Trademarks
Washington, D. C. 20231

Dear Sir:

Pursuant to MPEP 2001.06(c) Applicant is hereby notifying the Office that at least some of the subject matter being claimed is the subject of an existing litigation (Case No. 1:03-CV-00966, ED Wis), wherein the assignee Illinois Tool Works Inc. has sued Thermal Dynamics Corporation. Applicant is including copies of papers from that litigation, including:

Plaintiffs' Responses and Objections To Thermal Dynamics Corporation's Seventh Set Of Interrogatories


Answer, Affirmative Defenses, and Counterclaims To Plaintiffs' Third Amended Complaint

Plaintiffs' Responses and Objections to Thermal Dynamics Corporation's Interrogatories Nos. 22-37 (Eighth Set)

These documents are being provided because the Defendant has asserted the parent patents are invalid. The prior art referred to by the Defendant has previously been cited, or is cited herein.



Respectfully Submitted


George R. Corrigan, Reg. No. 34,803
Corrigan Law Office
5 Briarcliff Court
Appleton, WI 54915
(920) 954-1099

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8a)

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 5/27/02



George R. Corrigan



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Steven J. Geissler
Serial No.: 10/826534
Filing Date: April 16, 2004
Grp Art Unit: 2838
Docket No.: ITW 8637.62
For: Method And Apparatus For Receiving A Universal Input Voltage
In A Welding, Plasma Or Heating Power Source

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATION FOR INFORMATION DISCLOSURE STATEMENT
(37 CFR 1.97(e))

Note: A certification must state either: "(1) that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement, or (2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certificate after making reasonable inquiry, was known to any individual designated in § 1.56(c) more than three months prior to the filing of the statement." 37 CFR 1.97(e).

Note: "Section 1.97(e) makes it clear that a certification could contain either of two statements. One statement is that each item of information in an information disclosure statement was cited in a search report from a patent office outside the U.S. not more than three months prior to the filing date of the statement. Under this certification, it would not matter whether any individual with a duty actually knew about any of the information cited before receiving the search report. In the alternative, the certification could state that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual having a duty to disclose more than three months prior to the filing of the statement." Notice of January 9, 1992, 1135 O.G. 13-25, at 13. Thus: "If an item of information is submitted within three months of being cited in a communication from a foreign patent office in a counterpart foreign application, the certification can be properly made regardless of any individual's previous knowledge of the information." Id., 1135 O.G. at 19.

Note: "The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Thus, for example, the certification of 1.97(e) does not preclude the use of the certification in an application by corporations whose practitioners have over the years reviewed thousands of patents and technical publications, even though they are unaware of the relevance of any one thereof to the application. Notice of January 9, 1992, 1135 O.G. 13-15, at 19.

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8a)

I hereby certify that this correspondence is,
on the date shown below, being deposited with the U.S. Postal
Service as first class mail in an envelope addressed to:
Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

5/17/04
(Date)

George Corrigan

- Note: A copy of the foreign search report need not be submitted with the certification. Notice of April 20, 1992 (1138 O.G. 37-41, 40).
- Note: "The phrase 'after making reasonable inquiry' makes it clear that the individual making the certification has a duty to make reasonable inquiry regarding the facts that are being certified. The certification can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a certification under 37 CFR 1.97(e) (2) to the Office until a satisfactory response is received. The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Notice of April 20, 1992 (1138 O.G. 37-41, 39).
- Note: "Although it is recognized that an individual actually becomes aware of the information in the communication from a foreign patent office sometime after it was mailed, the mailing date of such a communication, if it occurs prior to a first awareness of the same information, would determine the date for filing of an information disclosure statement without a fee" in a certification procedure under § 1.97(e). Notice of January 9, 1992, 1135 O.G. 13-25, at 19.
- Note: "The certification under § 1.97(e) should be made by a person who has knowledge of the facts being certified. The certification can be made by a practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry." Notice of January 9, 1992, 1135 O.G. 13-25 at 19.
- Note: "The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application)." Notice of April 20, 1992 (1138 O.G. 37-41, 39).
- Note: "Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent or inventor." 37 CFR 1.56(d) and
- "Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:
- (1) each inventor named in the application;
 - (2) each attorney or agent who prepares or prosecutes the application; and
 - (3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 CFR 1.56(c).

IDENTIFICATION OF INFORMATION DISCLOSURE STATEMENT FOR WHICH THIS CERTIFICATION IS BEING MADE

1. This certification is being made for the Information Disclosure Statement accompanying this certification.

CERTIFICATION

2. I, the person(s) signing below certify that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual designated in § 1.56(c) more than three months prior to the filing of the statement. 37 CFR 1.97(e) (2).

- Note: "The time at which information 'was known to any individual designated in 37 CFR 1.56(c)' is the time when the information was discovered in association with the application even if awareness of the materiality came later." Notice of April 20, 1992 (1138 O.G. 37-41, 40).


IDENTIFICATION OF PERSON(S) MAKING THIS CERTIFICATION

3. The person making this certification is the attorney who signs below on the basis of information supplied by the inventor(s), by an individual designated in § 1.56(c) and in the attorney's file.

Note:

"Certification need not be in the form of an oath or a declaration under 37 CFR 1.68. Certification by a registered practitioner or any other individual that the statement was filed within the three-month period or either first citation by a foreign patent office or first discovery of the information will be accepted as dispositive of compliance with this provision in the absence of evidence to the contrary."...." A statement on information and belief would not be sufficient." Notice of April 20, 1992 (1138 O.G. 37-41, 39-40).

Reg. NO. 34,803


SIGNATURE OF ATTORNEY

George R. Corrigan
Corrigan Law Office
5 BriarCliff Ct.
Appleton, WI 54915

Tel. No. (920) 954-1099